Remarks

Claims 1 and 6 have been amended to more clearly define the invention. Claim 4 has been amended to correct an inadvertent error. Claim 12 has been amended to clarify what is claimed. New claim 29 has been added. Claim 2 has been canceled. These amendments are not the addition of new matter. Accordingly, Applicant respectfully ask that the amendments be entered.

In response to the Restriction Requirement, Applicants hereby affirm the provisional election to prosecute the invention of Group I, claims 1 – 22. Claims 23 – 28 stand withdrawn from further consideration.

Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. §112, first paragraph. Claim 4 has been amended to recite micrometers (old microns) instead of meters. Accordingly, Applicant respectfully ask that the rejection be withdrawn.

Applicant respectfully traverses the rejection of claims 4 and 12 under 35 U.S.C. §112, second paragraph.

Claim 4 has been corrected. Claim 12 has been amended to clarify which carbon fibers of claim 6 are being referenced. Accordingly, Applicant respectfully ask that this rejection be withdrawn.

Applicant respectfully traverse the rejection of claims 1 – 22 under 35 U.S.C. §102(b) over US Patent 5,998,307 to Lam et al., supported by M. Joseph in

Introductory Textile Science: Fifth Edition.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over Lam et al., alone or in combination with Joseph in the recitation of the fibrous base material including 5% to 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere do Lam et al. and Joseph, taken alone or collectively disclose this.

Further, Applicant respectfully submit that combining Joseph with Lam et al. is not a proper rejection.

Under 35 U.S.C. §102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim. In re Bond, 15 USPQ 2d 1566 (Fed.Cir. 1990).

Clearly, Lam et al. fail to anticipate Applicant's claims. Accordingly, Applicant respectfully ask that the Examiner withdraw this rejection under 35 U.S.C. §102.

Applicant respectfully traverses the provisional rejection of claims 1 – 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 9 of copending Application No. 10/678,725.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over the application in the recitation of the fibrous base material including 5% to 35%, by

weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does 10/678,725 even remotely disclose or suggest this. Nowhere does 10/68,725 disclose any type of partially carbonized carbon fibers, let alone the partially carbonized carbon fibers Applicant claims.

Further, nowhere does 10/678,725 disclose or remotely suggest the friction material structure claims 1, 6 and 29 recite.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of unpatentability. The Examiner's reasoning simply presumes that the product recited in the claims is obvious. The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992). With respect to obviousness-type double patenting, the Examiner must specifically point out the differences between the inventions defined by the references claims and the instant claims. The Examiner must then articulate the reasons why a person of ordinary skill in the art would conclude that the invention defined in the instant claims are an obvious variation of the invention defined in the reference claims. The Examiner has not pointed out the difference nor has the Examiner presented reasons supporting a conclusion that the difference is obvious variations. Simply

declaring that the references product suggest the now claimed product does not meet the burden.

Accordingly, Applicant respectfully asks that the Examiner withdraw this provisional rejection.

Applicant respectfully traverses the provisional rejection of claims 1 – 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 4 and 6 – 17 of copending Application No. 10/666,090.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over 10/666,090 in the recitation of the fibrous base material including 5% to 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does 10/666,090 even remotely disclose or suggest this. Nowhere does the application disclose any type of partially carbonized carbon fibers, let alone the partially carbonized carbon fibers Applicant claims.

Further, nowhere does 10/666,090 disclose or remotely suggest the friction material structure claims 1, 6 and 29 recite.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of unpatentability. The Examiner's reasoning simply presumes that the product recited in the claims is obvious. The Examiner bears the initial

burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992). With respect to obviousness-type double patenting, the Examiner must specifically point out the differences between the inventions defined by the references claims and the instant claims. The Examiner must then articulate the reasons why a person of ordinary skill in the art would conclude that the invention defined in the instant claims are an obvious variation of the invention defined in the reference claims. The Examiner has not pointed out the difference nor has the Examiner presented reasons supporting a conclusion that the difference is obvious variations. Simply declaring that the references product suggest the now claimed product does not meet the burden.

Accordingly, Applicant respectfully asks that the Examiner withdraw this provisional rejection.

Applicant respectfully traverses the provisional rejection of claims 1 – 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 26 of U.S. Patent No. 5,998,307.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over 5,998,307 in the recitation of the fibrous base material including 5% to 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does the patent even remotely disclose or suggest this. Nowhere does the patent disclose the partially carbonized carbon fibers Applicant claims.

Further, nowhere does 5,998,307 disclose or remotely suggest the friction material structure claims 1, 6 and 29 recite.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of unpatentability. The Examiner's reasoning simply presumes that the product recited in the claims is obvious. The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992). With respect to obviousness-type double patenting, the Examiner must specifically point out the differences between the inventions defined by the references claims and the instant claims. The Examiner must then articulate the reasons why a person of ordinary skill in the art would conclude that the invention defined in the instant claims are an obvious variation of the invention defined in the reference claims. The Examiner has not pointed out the difference nor has the Examiner presented reasons supporting a conclusion that the difference is obvious variations. Simply declaring that the references product suggest the now claimed product does not meet the burden.

Accordingly, Applicant respectfully asks that the Examiner withdraw this

provisional rejection.

Applicant respectfully traverses the provisional rejection of claims 1 – 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 33 of U.S. Patent No. 6,182,804.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over the patent in the recitation of the fibrous base material including 5% to 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does 6,182,804 even remotely disclose or suggest this. Nowhere does 6,182,804 disclose the partially carbonized carbon fibers Applicant claims.

Further, nowhere does 6,182,804 disclose or remotely suggest the friction material structure claims 1, 6 and 29 recite.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of unpatentability. The Examiner's reasoning simply presumes that the product recited in the claims is obvious. The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992). With respect to obviousness-type double patenting, the Examiner must specifically point out the differences between the inventions defined by the references claims and the instant claims. The Examiner must then articulate the reasons why a person of

ordinary skill in the art would conclude that the invention defined in the instant claims are an obvious variation of the invention defined in the reference claims. The Examiner has not pointed out the difference nor has the Examiner presented reasons supporting a conclusion that the difference is obvious variations. Simply declaring that the references product suggest the now claimed product does not meet the burden.

Accordingly, Applicant respectfully asks that the Examiner withdraw this provisional rejection.

Applicant respectfully traverses the provisional rejection of claims 1 – 22 under the judicially created doctrine of obviousness-type double patenting over claims 1 – 23 of U.S. Patent No. 6,001,750.

Claims 1, 3 – 22 and 29 as amended patentably distinguish over 6,001,750 in the recitation of the fibrous base material including 5% to 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does the patent even remotely disclose or suggest this. Nowhere does 6,001,750 disclose the partially carbonized carbon fibers Applicant claims.

Further, nowhere does the patent disclose or remotely suggest the friction material structure claims 1, 6 and 29 recite.

Applicant respectfully submits that the Examiner has failed to make out a

prima facie case of unpatentability. The Examiner's reasoning simply presumes that the product recited in the claims is obvious. The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir. 1992). With respect to obviousness-type double patenting, the Examiner must specifically point out the differences between the inventions defined by the references claims and the instant claims. The Examiner must then articulate the reasons why a person of ordinary skill in the art would conclude that the invention defined in the instant claims are an obvious variation of the invention defined in the reference claims. The Examiner has not pointed out the difference nor has the Examiner presented reasons supporting a conclusion that the difference is obvious variations. Simply declaring that the references product suggest the now claimed product does not meet the burden.

Applicant respectfully submit that claims 1, 3 – 22 and 29 as amended are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

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